

REMARKS

Claim 1 is amended to include the limitations of claims 2 and 3, claim 6 is amended to include the limitations of claims 7 and 8, and claim 11 is amended to include the limitations of claims 12 and 13. It should be understood that Applicant submits this amendment solely for the purpose of expediting prosecution and not for the purpose of distinguishing over the prior art. Applicant therefore reserves the right to pursue the subject matter of the amended and or canceled claims as may be desirable in subsequent prosecution.

New claims 16-22 are added to claim the invention in alternative language. Claims 1, 4-6, 9-11, and 14-22 remain pending.

The Office Action does not establish that claims 1, 5, 6, and 11 are unpatentable under 35 U.S.C.103(a) over US patent 6,518,787 to Allegrucci et al., (hereinafter "Allegrucci") and US patent 6,487,6557 to Wildgrube et al., (hereinafter "Wildgrube"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Allegrucci with teachings of Wildgrube, and fails to show that the combination could be made with a reasonable likelihood of success.

As a preliminary matter, Allegrucci is thought to not qualify as prior art under 35 USC §103(c). The present application was filed on 12/22/2000, and the present application and the Allegrucci patent were, at the time the invention of the present application was made, owned by Triscend Corporation. Therefore, the rejection is moot and should be withdrawn.

The Office Action fails to show that the Allegrucci-Wildgrube combination suggests all the limitations of claims 1, 5, 6, and 11. For example, claims 1, 6, and 11 include limitations of and related to searching for a valid secondary initialization routine to configure the system including system peripherals. The cited sections (col. 6, ll. 22-28; and col. 5, ll. 2-7) of Wildgrubbe make no apparent suggestion of any searching. Wildgrubbe's col. 6 simply references control transfer. Further explanation is requested for the specific elements of Wildgrubbe thought to correspond to the claimed searching so that the Applicants may reasonably evaluate the alleged

correspondence.

The Office Action is mistaken in alleging that a simple transfer of control corresponds to the claimed disabling of a memory alias. The memory alias refers to the addressing of the different memories using a common address space. Those skilled in the art will recognize that simply transferring program control does not imply, nor does it suggest disabling a memory alias. Thus, the Office Action fails to show that the Allegrucci-Wildgrube combination suggests these further limitations.

The limitations of claim 5 further refine the limitations of claim 1 as described above. Thus, the Office Action fails to show that the Allegrucci-Wildgrube combination suggests the limitations of claim 5 for at least the reasons set forth above.

The alleged motivation for combining Wildgrube with Allegrucci is conclusory and improper. The alleged motivation states that "it would have been obvious to one of ordinary skill in the art having the teachings of Allegrucci et al. and Wildgrube et al. before him at the time the invention was made to modify the CSOC to include the primary and secondary initialization instructions, because then the cooperative primary and secondary initialization would replace the unfriendly and error prone BIOS updating, as taught by Wildgrube et al." This alleged motivation, as far as it is understood, fails to provide any evidence that Allegrucci's configuration approach is in any way "unfriendly" or error prone. Furthermore, there is no evidence provided that any of Allegrucci's "unfriendliness" in programming would be overcome with teachings from Wildgrube. Further still, there is no evidence that elements of Allegrucci could be successfully modified with elements of Wildgrube.

The rejection of claims 1, 5, 6, and 11 over the Allegrucci-Wildgrube combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.

The Office Action fails to show that claims 2, 3, 7, 8, 12, and 13 are unpatentable under 35 U.S.C. 103(a) over the Allegrucci-Wildgrube combination claims 1, 5, 6, and 11, further in view of US patent 5,327,531 to Bealkowski et al., (hereinafter "Bealkowski"). The rejection is respectfully traversed because the Office

Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of the Allegrucci-Wildgrube combination with teachings of Bealkowski, and fails to show that the combination could be made with a reasonable likelihood of success. The limitations of claims 2, 3, 7, 8, 12, and 13 are now included in the respective parent independent claims 1, 6, and 11, and the explanation below references the parent independent claims.

Claims 1, 6, and 11 includes limitations of and related to configuring the system-on-a-chip using the secondary initialization routine located in the FLASH external memory; and resetting the CPU after completion of the configuring of the system-on-a-chip. It is respectfully submitted that Wildgrube's Abstract, as cited by the Office Action, suggests initializing the computer system on a reset. This clearly neither shows nor suggests that after completion of configuring the system-on-a-chip, the CPU is reset; Wildgrube resets the CPU before initialization, not after. The Office Action clearly fails to show that the Allegrucci-Wildgrube-Bealkowski combination suggests all the limitations of claims 1, 6, and 11.

The alleged motivation for modifying the Allegrucci-Wildgrube combination with Bealkowski is also improper. The alleged motivation states that "it would have been obvious ... to modify the CSOC to include the CSOC secondary initialization instructions, because then the secondary resource could be used as an alternative should the primary resource holding the primary initialization commands become corrupted." The claims clearly state that the code is executed both out of the internal memory and out of the external memory. With the cited teachings of Bealkowski, code would apparently execute out of one memory or another backup memory, but not both. Thus, Bealkowski's teachings would render any purported combination inoperable relative to the present invention.

The rejection of claims 2, 3, 7, 8, 12, and 13 over the Allegrucci-Wildgrube-Bealkowski combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.

The Office Action fails to show that claims 4, 9, 10, 14, and 15 are unpatentable under 35 U.S.C. 103(a) over the Allegrucci-Wildgrube-Bealkowski combination, as applied to claims 2, 3, 7, 8, 12, and 13, further in view of US patent 6,401,164 to Bartoli et al., (hereinafter "Bartoli"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of the Allegrucci-Wildgrube-Bealkowski combination with teachings of Bartoli, and fails to show that the combination could be made with a reasonable likelihood of success.

The limitations of these claims further refine the limitations of the claims discussed above. Therefore, the Office Action fails to show that the limitations are suggested by the combination.

The alleged motivation for combining Bartoli with the Allegrucci-Wildgrube-Bealkowski combination is conclusory and improper. For example, the Office Action cites "market demands" as the reason for the combination. However, no evidence is provided that the Allegrucci-Wildgrube-Bealkowski combination could not adequately satisfy market demands without Bartoli's teachings. Furthermore, the Office Action recites advantages of a single memory, when a single memory quite clearly contradicts the previously alleged motivation for having multiple memories. The alleged motivation is therefore improper.

The rejection of claims 4, 9, 10, 14, and 15 over the Allegrucci-Wildgrube-Bealkowski-Bartoli combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.


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CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

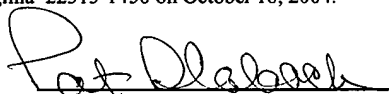
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patent, P.O. Box 1450, Alexandria, Virginia 22313-1450 on October 18, 2004.

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Signature